

REMARKS

The Examiner is thanked for the due consideration given the application and the withdrawal of the requirement for election of species mailed March 19, 2008.

Upon entry of this amendment, claims 30-32, 34, 35, 37, 38, 42, 43 and 46-50 are pending in the application. Claims 33, 36, 39-41, 44 and 45 are cancelled by this amendment. Claims 30-33, 36, 39-41, and 45 have been withdrawn from consideration. The claims have been amended to better set forth the invention being claimed.

No new matter is believed to be added to the application by this amendment.

Entry of this amendment under 37 CFR §1.116 is respectfully requested because it cancels claims and places the application in condition for allowance.

Rejection Under 35 USC §112, Second Paragraph

Claims 34, 35, 37, 38, 42-44, and 46-60 have been rejected under 35 USC §112, second paragraph, as being indefinite. This rejection is respectfully traversed.

Claims 34 (and dependent claims) and 48 recite the limitation "visualization probe or fluorescent or radioactive detection probe".

The Official Action considers that neither the claim nor the specification define which moieties fit this limitation, thus the skilled artisan would not be aware of the metes and

bounds of the claims. The Official Action emphasized that exemplification is not definition.

However, "[i]f the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds." *Exxon Res. & Eng'g Co. v. United States*, 265 P.3d 1371, 1375).

The present invention should not be rejected for indefiniteness, as the meaning of the claim is clearly discernible for one skilled in the art.

a) The present application recites: *"The expression 'visualization probe or fluorescent or radioactive detection probe' designates a molecular structure allowing the detection of a system by a physico-chemical technique, such as fluorescence or radioactivity. Among the fluorescent probes, there can be mentioned in particular the derivatives of fluorescein, dansyl (5-(dimethylamino)-naphthalenesulphonyl) or coumarin. Among the radioactive probes, there can be mentioned the products marked with a radioisotope."* (page 6, lines 26 to 31).

b) The Level of scientific knowledge of one skilled in the art is described as a Bachelor degree "[a]t least a Bachelor's degree in a scientific or engineering field" (Allvoice Computing 10/12/07), and one skilled in the art has a level of ordinary creativity (MPEP §2141.03).

Thus, a definition of what is considered a visualization probe or fluorescent or radioactive detection probe is provided (this definition does not require to be a model of clarity) (Praxair, 9/29/08), to a person with a scientific degree and average creativity.

It should be acknowledge that one skilled in the art would be able to discern the meaning of the claim, and consequently the metes and bounds of the claims.

Regarding claim 47 The Examiner considers that the wording "comprising" introduced October 6, 2008 is open language and permits the inclusion of other elements in addition to tris(2-hydroxymethyl)methylamine. However, claim 47 has been amended to recite "consisting" language.

The claims are thus clear definite and have full antecedent basis.

This rejection is believed to be overcome, and withdrawal thereof is respectfully requested.

Amended Claims

The Examiner is thanked for graciously contacting the applicant's representative on December 22, 2008.

Group IV, drawn to a cyclodextrin derivative containing a biorecognition element, was elected in the reply filed on December 28 2007.

An amended set of claim with removal of the nonelected subject-matter, and wherein Z represents a thiourea group, is provided.

Rejoinder request

Upon allowance the applicant respectfully requests rejoinder of the invention Group II drawn to a process for the preparation of a cyclodextrin derivative containing a biorecognition element.

In order to comply with the allowable subject matter found in invention group IV invention group II has been restricted to the cyclodextrin derivatives wherein Z represents a thiourea group.

Conclusion

The Examiner is thanked for considering the Information Disclosure Statement filed March 30, 2006 and for making an initialled PTO-1449 Form of record in the application.

Prior art of record but not utilized is believed to be non-pertinent to the instant claims.

It is believed that the rejections have been overcome, obviated or rendered moot and that no issues remain. The Examiner is accordingly respectfully requested to place the application in condition for allowance and to issue a Notice of Allowability.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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